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David B. Johnson

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7590
David B. Johnson
576 N. St. Asaph St.
Alexandria, VA 22314

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LOWE, MICHAEL S

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID B. JOHNSON and JEFFREY A. SCHMIDT

Appeal 2008-2072
Application 10/626,529
Technology Center 3600

Decided: September 12, 2008

Before HUBERT C. LORIN, JENNIFER D. BAHR, and MICHAEL W.
O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

David B. Johnson, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-14. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.¹

THE INVENTION

The claimed invention relates to an extender-arm (Spec. 1:5).

Claims 1, reproduced below, is representative of the subject matter on appeal.

1. An extender-arm comprising:

a handle section, said handle section comprising an actuator, a proximal end, and a distal end, wherein a tool receiving socket is disposed at said proximal end, said tool receiving socket including a connection structure for connection with a tool inserted in said socket; and

an open-and-close section connected to said distal end of said handle section so as to be operable by said actuator.

THE PRIOR ART

The Examiner relies upon the following as evidence of unpatentability:

Lake	US 4,726,263	Feb. 23, 1988
Burns	US 5,116,093	May 26, 1992
Miller	US 5,685,586	Nov. 11, 1997
Kalidindi	US 5,823,592	Oct. 20, 1998
McConnell	US 6,390,427	May 21, 2002
McCalla	US 6,419,371 B1	Jul. 16, 2002

THE REJECTIONS

The following rejections are before us for review:

¹ Our decision will make reference to Appellants' Appeal Brief ("Br.," filed Jul. 5, 2006) and the Examiner's Answer ("Ans.," mailed Feb. 6, 2007).

Claims 1-5, 10, 11, and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lake and McCalla.

Claims 6-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lake, McCalla, and McConnell.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lake, McCalla, and Kalidindi.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lake, McCalla, and Miller.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lake, McCalla, and Burns.

For claims 1, 2, 10, and 11, the Appellants contend Lake and McCalla fail to teach or suggest an open-and-close section. (Br. 8-9.) The Appellants have argued claims 1, 2, 10, and 11 as a group. We select claim 1 as representative of the group. Claims 2, 10, and 11 stand or fall with claim 1.

For claim 3, the Appellants contend that claim 3 sets forth that the open-and-close section is a gripping section and that, in contrast, Lake teaches a gripping end which allows the user to grip the tool (Br. 9).

For claim 5, the Appellants contend that McCalla does not specifically teach or suggest a rechargeable power supply (Br. 9).

For claim 14, the Appellants contend that there is nothing about Lake's handle 12 that would render it capable of grasping and holding an object (Br. 9).

For claims 6-8, the Appellants contend Lake, McCalla, and McConnell fail to teach or suggest all of the elements as set forth and

arranged in the claims. (Br. 10.) In other words, the Appellants contend Lake and McCalla are deficient with respect to claims 1 and 2 and McConnell does not cure the deficiencies of Lake and McCalla. (Br. 10.) The Appellants have argued claims 6-8 as a group. We select claim 6 as representative of the group. Claims 7 and 8 will stand or fall with claim 6.

For claim 9, the Appellants contend Lake, McCalla, and Kalidindi fail to teach or suggest all of the elements as set forth and arranged in the claim. (Br. 10.) In other words, the Appellants contend Lake and McCalla are deficient with respect to claims 1 and 2 and Kalidindi does not cure the deficiencies of Lake and McCalla. (Br. 10.)

For claim 12, the Appellants contend Lake, McCalla, and Miller fail to teach or suggest all of the elements as set forth and arranged in the claims. (Br. 10.) In other words, the Appellants contend Lake and McCalla are deficient with respect to claim 1 and Miller does not cure the deficiencies of Lake and McCalla. (Br. 10.)

For claim 13, the Appellants contend Lake, McCalla, and Burns fail to teach or suggest all of the elements as set forth and arranged in the claims. (Br. 10-11.) In other words, the Appellants contend Lake and McCalla are deficient with respect to claim 1 and Burns does not cure the deficiencies of Lake and McCalla. (Br. 10-11.)

ISSUES

The first issue is whether Lake and McCalla describe an open-and-close section.

The second issue is whether Lake and McCalla describe an open-and-close section having a gripper section.

The third issue is whether Lake and McCalla describe a rechargeable battery supply.

The fourth issue is whether Lake and McCalla describe an open-and-close section having a gripper section that is configured to grasp and hold an object.

FINDINGS OF FACT

We find that the following enumerated findings of fact are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Scope and content of the prior art

1. Lake describes a device 9 for extending the reach of a driver within a vehicle. The device 9 is constructed with an elongated handle 10 having an operating end 11 and a “gripping end 12.” The handle 10 is of a telescoping configuration comprising a sleeve side 10a and a retractable side 10b. The retractable member 10b includes a position-lock spring button 13 that may be selectively seated in any of several lock button holes 14. A spring biasing lever arm 15 is secured to the retractable side 10b. Both sleeve side 10a and retractable side 10b are fitted with a tracking slot 16. In the fully extended position, the spring lock button 13 is in the distal hole 14a of sleeve side 10a. In

the retracted position, the spring lock button 13 is positioned in a retention opening 18 that holds the retractable member 10b in its retracted position within the sleeve 10a. The gripping end 12 is constructed with a handle grip 21. (Lake, col. 2, l. 60 to col. 3, l. 25; Fig. 1.)

2. McCalla describes, in a device 10 containing a light source 50 to be used in poorly-lit environments, a power means that can be any energy source known in the art to energize the light source 60, e.g., chemical or electrical. A preferred embodiment for the power means is removable batteries 70. (McCalla, col. 5, ll. 47-52.)
3. The Examiner finds rechargeable batteries are an energy source well known in this art. (Ans. 8.)

Differences between the claimed subject matter and the prior art

4. The claimed invention combines elements separately disclosed in the prior art.

Level of ordinary skill in the prior art

5. Neither the Examiner nor Appellant has addressed the level of ordinary skill in the pertinent arts of hand-held devices that assist a driver to reach an object or illuminate a poorly-lit area within a vehicle. As such, we will therefore consider the cited prior art as representative of the level of ordinary skill in the art.

Secondary considerations

6. No evidence of secondary considerations has been presented for our review.

PRINCIPLES OF LAW

We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims “their broadest reasonable interpretation consistent with the specification” and “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily). In other words, “particular embodiments ... in the specification will not generally be read into the claims.” *Constant v. Advanced Micro-Devices*, 848 F.2d 1560, 1571 (Fed. Cir. 1988). Moreover, “[a]bsent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification or prosecution history when those sources expressly disclaim the broader definition.” *In re Bigio*, 381 F.3d 1320, 1325 (Fed Cir. 2004).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the

prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

The Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248,” *KSR* at 1739 (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR* at 1739. The operative question in this “functional approach” is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR* at 1740.

ANALYSIS

Claims 1, 2, 10, and 11

When claim 1 is properly construed and its breadth understood, we find Lake’s description of an elongated handle 10 satisfies the claimed open-and-close section of claim 1. As noted above, claims are construed in light of the Specification without reading limitations from the Specification into the claims or reading a particular embodiment into the claim or narrowing the meaning of claim language unless the Specification or prosecution

history expressly disclaims a broader definition. The Specification is silent with respect to a definition for the term “open-and-close section.” The prosecution history does not expressly disclaim a broad definition of “open-and-close,” but instead discloses that section 30 “may be formed in a manner” as disclosed in US Patent 6,520,556. (Amendment, page 6, Feb. 22, 2005; Br. 8.) Appellants’ argument amounts to a request to limit a claim term to a particular embodiment that is being incorporated by reference into the Specification. Because no definition is provided in the Specification and no express disclaimer has been stated, we are left to construe the claim with the broadest reasonable interpretation in light of the Specification as it would be interpreted by one of ordinary skill in the art.

The Specification discloses the “open-and-close section” encompasses pliers, scissors, or the like. (Spec. 8 and 9.) As such, the term “open” could reasonably encompass extension while, the term “close” would encompass the opposite, retraction. Therefore, the term “open-and-close section” could encompass a section that has an extended position and a retracted position.

Lake’s elongated handle 10 satisfies the claimed “open-and-close section” when the claim term is properly construed. Lake describes the elongated handle 10 having an extended position and a retracted position. (Fact 1). As such, given the breadth of the term, “open-and-close section” reads on Lake’s telescoping elongated handle 10.

The Appellants’ contention that Lake fails to teach or suggest an “open-and-close section” does not persuade us of an error in the Examiner’s rejection of claims 1, 2, 10, and 11. Accordingly, we will sustain the Examiner’s rejection of claims 1, 2, 10, and 11.

Claim 3

The Appellants do not persuade us of an error in the Examiner's rejection with the contention that claim 3 sets forth the "open-and-close section *is a* gripping section." (Br. 9)(emphasis added.) Claim 3 recites "said open-and-close section *comprises a* gripping section." (Claim 3.)(emphasis added.) Moreover, Appellants' contrast of Lake's gripping end 12 allowing the user to grip the tool with something that would allow a user to grasp onto an object with the tool implies a narrower reading of "gripping section" than that language dictates. In other words, the claim language "gripping section" is merely a label and does not specify a structure that itself performs a gripping function. For these reasons, the contention is not commensurate in scope to the claim. When claim 3 is properly read, Lake satisfies the limitation of "said open-and-close section comprises a gripping section." Lake describes the elongated handle 10 as having at one end a "gripping section 12" (Fact 1.) We cannot conclude, on this record, that Lake's explicit teaching of a "gripping end" does not satisfy the limitation of a "gripping section" in claim 3. Accordingly, the limitation "wherein said open-and-close section comprises a gripping section" reads on Lake's elongated handle 10 having a gripping section 12 at one end.

The Appellants' contention that claim 3 sets forth that the open-and close section is a gripping section does not persuade us of an error in the Examiner's rejection of claim 3. Accordingly, we will sustain the Examiner's rejection of claim 3.

Claim 5

The Appellants do not persuade us of an error in the Examiner's rejection with the contention that because McCalla does not specifically teach or suggest a rechargeable power supply claim 5 is nonobvious. McCalla describes the power supply as any energy source known in the art that can energize light source 60. (Fact 2.) McCalla teaches a preferred energy source is removable batteries 70. (Fact 2.) Those of ordinary skill in this art understand that removable batteries of the type that would be used in hand-held devices such as what is described in McCalla fall into two categories: non-rechargeable, e.g. alkaline, and rechargeable, e.g. lithium-ion and nickel-cadmium. Accordingly, we find because McCalla describes any energy source known to be able to energize the light source 50 and teaches the preferred energy source is removable batteries 70, and those batteries in this art fall into two categories - rechargeable or non-rechargeable, one of ordinary skill in the art could use rechargeable batteries as the energy source to power the light source 60. Moreover, the Examiner finds rechargeable batteries are known in this art. (Fact 3.) Appellant does not challenge this finding. If the Appellant does not seasonably traverse the Examiner's taking of Official Notice, then the object of the Official Notice is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 711, 713 (CCPA 1943) ("In the absence of anything in the record to contradict the examiner's holding, and in the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). Accordingly, Lake, McCalla, and what has been admitted as prior art describe each element of the claimed subject matter and its corresponding function. "[W]hen a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no

more than one would expect from such an arrangement, the combination is obvious.” *KSR* at 1740, (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282, 96 S.Ct. 1532 (1976)).

As such, the Appellants’ contention that because McCalla does not specifically describe the use of a rechargeable power supply, claim 5 is nonobvious does not persuade us of an error in the rejection of claim 5. Accordingly, we will sustain the Examiner’s rejection of claim 5.

Claim 14

We will not sustain the rejection of claim 14. Claim 14 requires the gripping section to be configured to grasp and hold an object. Lake’s gripping section 12 is a bicycle handle 21. (Fact 1.) As the Appellants have pointed out, a bicycle handle is not capable of grasping and holding an object. (Br. 9.) The Examiner has not relied on McCalla to cure the deficiency within Lake. As such, the Appellants have identified an error in the Examiner’s rejection with respect to the scope and content of Lake.

Claims 6-9, 12, and 13

The Appellants rely on the arguments raised against the rejection of claims 1 and 2. (Br. 10-11.) Given that we find those arguments unpersuasive as to error in the rejection of claims 1 and 2, we reach the same conclusion with regard to the arguments as they apply to the rejections of these claims; that is, we find them unpersuasive as to error in the rejections.

CONCLUSIONS OF LAW

We conclude that the Appellants have not identified an error in the Examiner's rejection of claims 1-5, 10, and 11 as being unpatentable over Lake and McCalla.

We conclude that the Appellants have not identified an error in the Examiner's rejection of claims 6-8 as being unpatentable over Lake, McCalla, and McConnell.

We conclude that the Appellants have not identified an error in the Examiner's rejection of claim 9 as being unpatentable over Lake, McCalla, and Kalidindi.

We conclude that the Appellants have not identified an error in the Examiner's rejection of claim 12 as being unpatentable over Lake, McCalla, and Miller.

We conclude that the Appellants have not identified an error in the Examiner's rejection of claim 13 as being unpatentable over Lake, McCalla, and Burns.

We conclude that the Appellants have identified an error in the Examiner's rejection of claim 14 as being unpatentable over Lake and McCalla.

DECISION

The Examiner's decision to reject claims 1-13 is affirmed.

The Examiner's decision to reject claim 14 is reversed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

JRG

David B. Johnson
576 N. St. Asaph St.
Alexandria, VA 22314